

## REMARKS

The specification has been amended to correct the spelling of the compound at page 9/ln 2 and to insert the language from original claim 15 in the description for compounds 6 and 12 at page 9/ln 23 and page 11/ln 2. Support for the language "bearing a 6-phenylsulfonylmethylcarbonamido group" is found in the chemical formulas for compounds (6) and (13) and in original claim 15. Claim 7 is amended to clarify the "6-amino" reference in the claim.

Claim 1 stands rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure, which is not enabling. According to the Examiner, the process steps i.e., solvents(s) necessary to practice the invention which is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure.

It is noted that the process step of claim 1 corresponds to the reaction for making of compounds 4 and 12 in the two schemes detailed in the examples. These steps in both of these schemes call for a solvent of ethyl acetate. The use of pyridine is not essential as it was used to make (4) but not (12). Claim 1 has been amended to make it clear that the claim is to the use of the specific step as one in the overall process of making the ultimate end product described in the preamble of the claim, although this is believed to be clear from the chemical names in the claim..

Claims 1, 5, 7-12, 14-16 and 18 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. According to the Examiner: "In claim 1, it is not clear how the preparation of the final product is accomplished."

It is believed that the claim is directed to one individual step in the multi-step reaction and the remaining steps, although enabled, are not specific limitations to the patentability of the claimed step.

2. According to the Examiner: "In claims 5 and 12, what is meant by "a normal alkyl group."? Additionally, claim 5 is drawn to a description not a process and the claim does not further limit the scope of claim 1."

The term "normal alkyl" is well-known in organic chemistry to mean a straight chain alkyl hydrocarbon group without any branching. See enclosure with marked passage of Grant and Hackh's CHEMICAL DICTIONARY 4th ed.(1987) page 402.

3. According to the Examiner: "In claims 14 and 18, the term "comprising", line 1 in each instance, cited in the claim is inclusive and fails to exclude unrecited elements. The use of the term comprising to introduce claimed structure means that the ingredients covered by this claim may involve more elements than those positively recited. See *Exparte Gottzein et al.*, 168 USPQ 176 (PTO Bd. App. 1969). Comprising leaves the claim open for the inclusion of unspecified ingredient or elements even in major amounts. Also see *Exparte Davis et al.*, 80 U.S.P.Q. 448 (PTO Bd. App 1948)."

Applicants agree with the Examiner's interpretation of the term "comprising". However use of that term is not a basis for rejection *per se* as the Examiner appears to suggest. In fact 99% of all allowed patent claims contain that word.

4. The Examiner inquires: In claim 7, which 6-amino group is applicants referring to?

Claim 7 is directed to the step subsequent to the step of claim 1 and, consequently, refers to the product of the step of claim 1: "2-alkyl-6-amino-7-chlorobenzoxazole in which the 2-alkyl group is unbranched at the  $\alpha$  carbon". The present amendment clarifies this fact.

5. The Examiner asserts: 'In claims 8 and 9, the phrase "the further subsequent" and "the still further", line 1 in each instance is idiomatic and therefore indefinite.'

Applicants respectfully disagree. These claims are directed to subsequent reaction steps following the step of claim 7. It is not understood what is idiomatic and what is unclear about the language.

6. The Examiner notes: "Claims 10, 11 and 16 are drawn to a description of compounds not specific compounds."

The claims are directed to a generic description of a class of compounds. It is not necessary that one claim specific compounds when the invention is generic in nature.

7. The Examiner asserts: "Claim 15 recites the limitation "phenylsulfonylmethylcarbonamido" in line 2. There is insufficient antecedent basis for this limitation in the claim."

Applicants have remedied any concerns by inserting the language in the specification based on the original disclosure of the structures in the examples and in claim 15.

8. The Examiner notes: "A spelling error has been noted in the specification on page 9, under compound 6,6-amino5, 7-dichloro-2-methylbenzoxazole has been misspelled as "6-amino5,7-dihloro-2-methylbenzoxazole".

The spelling has been corrected.

The Examiner noted that "Claims 2-4, 6 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims."

It is believed that the present amendments rectify all valid patentability concerns. The Examiner is respectfully requested to withdraw the outstanding rejection and to pass the subject application to Allowance.

Respectfully submitted,



Attorney for Applicant(s)  
Registration No. 25,518

Arthur E. Kluegel/dlm  
Rochester, NY 14650  
Telephone: 585-477-2625  
Facsimile: 585-477-1148

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.

Encl: Grant & Hackh's